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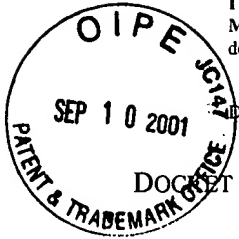
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Date: September 5, 2001

By: Lynnea B. Anderson

DOCKET No.: 8255-0028.30

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Pelrine et al.

SERIAL NO.: 09/810,919

FILED: March 16, 2001

FOR: **MICROLABORATORY DEVICES AND METHODS**

EXAMINER: Unassigned

ART UNIT: 1741

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OFFICE OF PETITIONS
DEPUTY A/C PATENTS

Petition under 37 CFR §1.47(a)

Applicants hereby petition, under 37 CFR §1.47(a), to make the present application on behalf of themselves and the omitted inventor, Subramanian Venkat Shastri, who has refused to join in the application. Provided herein, in accordance with this section, are proof of the pertinent facts, the last known address of the inventor, and the petition fee of \$130.00.

Declaration of Facts

I, the undersigned, am the attorney of record for this case. The following describes my knowledge of the situation.

Subramanian Venkat Shastri was listed as one of three co-inventors on the subject application as filed. Following his work on the invention, his employment at SRI International (SRI) was terminated. His most recent known address is: 4373 Miller Avenue, Palo Alto, California 94306. Telephone: (650) 947-0461.

The Notice to File Missing Parts in the application was received in our office on August 7, 2001, and documents to be signed (declarations, powers of attorney, and assignments) were sent to SRI on June 13, 2001 (a copy of the cover letter is enclosed). It is our standard policy to send these documents to the assignee, and we were not instructed to send any documents directly to Subramanian Venkat Shastri.

At the time the documents were mailed to SRI for the inventors' signatures, I was not aware of any specific problem regarding any particular inventor.

Our office received the balance of the signed documents from SRI on August 22, 2001 along with a letter from Edward E. Davis, Manager, Intellectual Property of SRI (copy enclosed).

09/13/2001 5LUANG1 00000007 500665 09810919

01 FC:122 130.00 CH

As outlined in that letter, enclosed are the following documents supporting continued efforts to obtain the signature of the co-inventor, Subramanian Venkat Shastri.

1. A copy of a letter dated June 25, 2001 from SRI to Subramanian Venkat Shastri enclosing documents to be signed after reviewing the copy of the application, also enclosed.
2. A memo to the file from MaryLou Joyner dated July 26, 2001, regarding a response from a verbal reminder to please review, sign, and return the documents.
3. A copy of a reminder sent to Subramanian Venkat Shastri by US mail, return receipt requested.
4. A memo from E. Davis to the file regarding a telephone conversation with Subramanian Venkat Shastri in which he explains his lack of cooperation.
5. A copy of Subramanian Venkat Shastri's Employment Agreement indicating his obligation to cooperate.

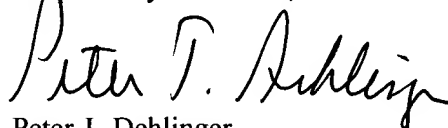
The inventor was thus presented with a copy of the complete application papers, in accordance with MPEP §409.03(d), in addition to receiving the documents to be signed from SRI in June. E. Davis of SRI called Subramanian Venkat Shastri at his home number and spoke to him regarding the need to submit the signed documents to the Patent Office in a timely fashion.

Conclusion

The applicants submit that this petition complies with the requirements of 37 CFR §1.47(a) and MPEP §409.03(d), and gives documented evidence that the missing inventor refused to join in the application after a diligent effort was made to obtain his signature on the application papers.

Date: 09-05-01

Respectfully submitted,



Peter J. Dehlinger
Registration No. 28,006

Correspondence Address:

Phone: (650) 838-4300

Customer No. 22918

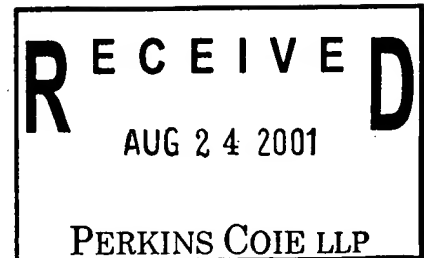


VIA FEDERAL EXPRESS

22 August 2001

Peter J. Dehlinger, Esq.
Perkins Coie, LLP
101 Jefferson Drive
Menlo Park, CA 94025-1114

Re: US Patent Application No. 09/810919
MICROLABORATORY DEVICES AND METHODS
SRI Ref.: US-3878-2
Your Ref.: IotaPi 8255-0028.30



Dear Peter,

Enclosed are executed Declarations and Powers of Attorney and Assignments for the above referenced patent application from two of the three inventors. Both Ron Pelrine and Jose Joseph have executed and returned the documents as requested. The third inventor, Subramanian Venkat Shastri, has not been as cooperative. The likelihood of his attention to and compliance with our request within the time for responding to the Notice of Missing Parts is extremely low. His termination from SRI was on less than friendly terms and he is very angry with SRI. He acknowledges receipt of the application for his review and the documents for his signature, but refuses to complete the process in the foreseeable future. We have been in contact with him and I feel that we are dealing with an uncooperative inventor to the extent that a 1.47(a) petition will be necessary. As a result, I have enclosed the following:

A copy of the initial letter of June 25, 2001, sent regular US 1st class mail requesting his review of the application and signature of the documents;

A memo to the file from MaryLou Joyner, re: a response from a verbal reminder to please review and sign and return the documents;

A copy of a reminder sent to him by US mail, return receipt requested;

A memo from me to the file, re: a telephone conversation with Venkat in which he indicated his lack of cooperativeness; and

A copy of Venkat's Employment Agreement indicating his obligation to cooperate.

The current contact information I have for Venkat is his home:

4373 Miller Ave.
Palo Alto, CA 94306
Telephone: 650-947-0461

SRI International
Intellectual Property Office
333 Ravenswood Avenue
Menlo Park, California 94025-3493

Telephone: (650) 859-4022

Facsimile: (650) 859-6420

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Please let me know if there are any other steps that I should take or is there any other information you need to support a §1.47(a) petition. We would like to respond to the Notice of Missing Parts before the next extension is due--i.e., **before September 7th**. In addition, I leave for vacation on the 7th, returning October 2.

Thanks for your help with this matter.

Regards,

A handwritten signature in black ink, appearing to be 'Ed' with a stylized flourish.

Edward E. Davis
Manager, Intellectual Property

Enclosures



June 25, 2001

Ronald E. Pelrine
180 Iroquois Drive
Boulder, CO 80303

Subramanian Venkat Shastri
4373 Miller Avenue
Palo Alto, CA 94306

Re: SRI Docket US3878-2
Pelrine et al., LEVITATED PARTICLE SYSTEM AND METHOD
US Patent Application Serial No. 09/810919, Filed 3/16/01

Dear Inventors:

Enclosed are copies of two documents pertaining to the subject patent application, which documents have already been signed by Inventor Joseph. A copy of the application is also enclosed.

Please do the following, using blue ink:

1. Sign and date the Inventorship Declaration.
2. Sign and date the Assignment.

The signed papers should be returned to me in the enclosed self-addressed envelope. If you encounter a problem, please do not hesitate to give me a call or send an e-mail. As for the copy of the application, it should either be kept in a place not accessible to others or shredded.

In advance, thanks for your cooperation.

Sincerely,

Mary Lou Joyner
Intellectual Property Paralegal
Tel.: (650) 859-4099
Fax: (650) 859-6420
E-mail: mary.joyner@sri.com

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SRI International
Intellectual Property Office
333 Ravenswood Avenue
Menlo Park, California 94025-3493

Telephone: (650) 859-4022

Facsimile: (650) 859-6420

**Memo to the file: US Patent Application No. 09/810919 filed March 16, 2001;
MICROLABORATORY DEVICES AND METHODS
SRI Ref.: US-3878-2**

From: MaryLou Joyner, SRI IP Office

July 26, 2001

Today, I received a message on my telephone answering system from inventor, Venkat Shastri, in response to a telephone call I had placed to his home telephone inquiring about when SRI might expect his responding to the letter I sent to him dated June 25, 2001, asking him to review the above referenced patent application and to sign and return the Declaration and Power of Attorney and the Assignment that were enclosed.

In the message I received, Mr. Shastri stated that he had not had time to review the application. He would do so when he has time. He requested that he not be called at home: "that's not going to help me in getting more time." He said that he has received all the information that he needs to sign the papers.

Mary Lou Joyner

**SENDER: COMPLETE THIS SECTION**

- Complete items 1, 2, and 3. Also complete item 4 if Restricted Delivery is desired.
- Print your name and address on the reverse so that we can return the card to you.
- Attach this card to the back of the mailpiece, or on the front if space permits.

1. Article Addressed to:

SUBRAMANIAN VENKAT
SHASTRI
4373 MILLER AVE
PALO CA 94306

COMPLETE THIS SECTION ON DELIVERY

A. Received by (Please Print Clearly) B. Date of Delivery

C. Signature

X *Vj. shb*☐ Agent
☐ AddresseeD. Is delivery address different from item 1? ☐ Yes
If Yes, enter delivery address below: ☐ No

3. Service Type

☒ Certified Mail ☐ Express Mail
☒ Registered ☐ Return Receipt for Merchandise
☐ Insured Mail ☐ C.O.D.4. Restricted Delivery? (Extra Fee) ☐ Yes

2. Article Number (Copy from service label)

7000 0520 0018 7116 7883

PS Form 3811, July 1999

Domestic Return Receipt

102595-00-M-0952

UNITED STATES POSTAL SERVICE



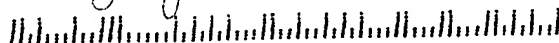
First-Class Mail
Postage & Fees Paid
USPS
Permit No. G-10

• Sender: Please print your name, address, and ZIP+4 in this box •

SRI International
333 Ravenswood Avenue
Menlo Park, California 94025

ML Joynce

4025+3453

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Reminder

June 25, 2001

Ronald E. Pelrine
180 Iroquois Drive
Boulder, CO 80303

Subramanian Venkat Shastri
4373 Miller Avenue
Palo Alto, CA 94306

Re: SRI Docket US3878-2
Pelrine et al., LEVITATED PARTICLE SYSTEM AND METHOD
US Patent Application Serial No. 09/810919, Filed 3/16/01

Dear Inventors:

Enclosed are copies of two documents pertaining to the subject patent application, which documents have already been signed by Inventor Joseph. A copy of the application is also enclosed.

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1. Sign and date the Inventorship Declaration.
2. Sign and date the Assignment.

The signed papers should be returned to me in the enclosed self-addressed envelope. If you encounter a problem, please do not hesitate to give me a call or send an e-mail. As for the copy of the application, it should either be kept in a place not accessible to others or shredded.

In advance, thanks for your cooperation.

Sincerely,

Mary Lou Joyner
Intellectual Property Paralegal
Tel.: (650) 859-4099
Fax: (650) 859-6420
E-mail: mary.joyner@sri.com

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Memo to the file: US Patent Application No. 09/810919 filed March 16, 2001;
MICROLABORATORY DEVICES AND METHODS
SRI Ref.: US-3878-2

From: Edward E. Davis, 
Manager, Intellectual Property Office

Tuesday, August 21, 2001, 6:45pm--

I spoke by telephone with inventor, Subramanian Venkat Shastri, at his home (650-947-0461) at the above time and date, to inquire about when he would be able to comply with our request to review the patent application and sign and return the Declaration and Power of Attorney and the Assignment to SRI. I identified myself as the manager of the SRI IP Office and that I am responsible for the patent process at SRI which included providing information and documents in proper form and a timely manner to the attorneys preparing and prosecuting SRI's patent applications.

I asked Venkat if he had received the letter from the SRI Intellectual Property Office dated June 25, 2001, enclosing a copy of the patent application and the documents we requested that he sign and return. He said that yes he had received the documents, but that he had not had the time to deal with them.

I asked him if he had received our reminder letter dated August 6, 2001. He said yes he had.

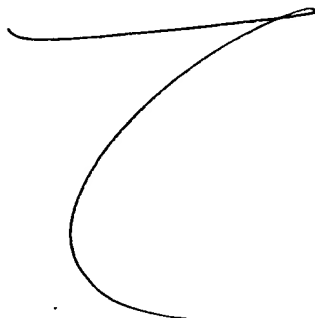
I explained that I was concerned because the due date for responding to Notice of Missing Parts from the US PTO had passed on July 7, 2001, that we were now incurring late fees, and that we had an absolute, non-extendable deadline approaching. He responded, "I don't have the time to look at that stuff. I have a new job and other things that are more important to me at this time. I don't know when I will get to it. It is on the very bottom of my priority list."

When I asked when he thought he might be able to review the application and respond to our request, he said, "I won't even guess when I might get to it."

When I reminded him that he had an obligation to respond to SRI's request, he stated that he knew that he had an obligation to respond, but that he didn't care and that being compensated for his time doesn't matter; that SRI's deadlines and late fees meant nothing to him. He indicated that his termination from SRI was very unpleasant and that he was very angry with his former supervisor about the way he was treated. He stated that he had no loyalty to SRI, that his managers "treated me like (expletive deleted)."

I said that because of the need to respond immediately to avoid incurring further late fees that SRI would proceed with the application process without his cooperation. I thanked him for speaking with me and explaining his position. Our conversation was "cordial," but business-like and to the point.

My impression at the conclusion of our conversation was that because of the nature of his termination from SRI, we were at high risk that he might not deal with the matter before the response period plus extensions expired, if ever!





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In consideration of my employment at SRI International, I agree:

1. To perform the duties assigned to me to the best of my ability, and to abide faithfully by SRI policies and practices.
2. To treat as confidential all results, intermediate and terminal, of SRI research activity in which I may participate or of which I may obtain knowledge during my employment, together with all formulae, specifications, secret processes, trade secrets, and such other confidential information belonging to SRI or its clients as may come to my knowledge in the course of or incidental to my employment, and that I shall at all times recognize and protect such property rights of SRI and its clients and not disclose same to unauthorized persons. Because much of the work done by SRI for the Government is classified, I am aware that my continued employment may depend on my ability to qualify for and to maintain an appropriate Government clearance. I also agree that I will not divulge to any unauthorized persons any classified information revealed to me during the period of my employment, and that all classified material received or generated by me will be handled in accordance with SRI Security Guide. I further warrant that to the best of my knowledge I do not at the time of my employment have in my possession, or under my control, any material which contains "CLASSIFIED INFORMATION" as defined in U.S. Government Industrial Security directives.
3. To promptly disclose to SRI all discoveries, improvements, and inventions, including software, conceived or made by me during the period of my employment, and I agree to execute such documents, disclose and deliver all information and data, and to do all things which may be necessary or in the opinion of SRI reasonably desirable, in order to effect transfer of ownership in or to impart a full understanding of such discoveries, improvements and inventions to SRI or to its nominee and to no other. I agree to comply with every reasonable request of SRI, its nominee, or the representative of either, for assistance in obtaining and enforcing patents. I understand that termination of this employment shall not release me from my obligations hereunder (as well as paragraph 2 above) provided, however, that time actually spent by me in discharging these obligations after termination of my employment shall be paid for by SRI at a reasonable rate. It is, of course, understood and agreed that I accept no responsibility for any out-of-pocket fees, costs, or expenses incurred or involved in the preparation, filing or prosecution of any application for patent or in the prosecution or defense of any litigation involving the same, and that I shall be reimbursed by SRI for any expense to which I may be put at the request of it or its nominee hereunder. This agreement does not apply to an invention which fully qualifies for the exclusion under Section 2870 of the California Labor Code which is reprinted on the reverse side of this agreement. However, all such inventions must be disclosed so that a determination can be made that they do in fact qualify for exclusion. All such disclosures will be treated as confidential.
4. That with respect to the subject matter thereof, this agreement covers my entire agreement with SRI, superseding any previous oral or written understandings or agreements with SRI or any representative thereof.
5. That my employment is not for any particular term and therefore this agreement is terminable, with immediate effect, at the will of either party.

Executed at Menlo Park, California this 15th day of October, 1996

Victoria Johnson
Witness to Signature

Subraman
Staff Member

Print Name: Subramanran Venkataraman
SHASTRI

By: [Signature]
Human Resources, for SRI International